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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,297	10/05/1999	KANG TING	3100.006US0	9486
33401	7590	09/13/2004	EXAMINER	
MCDERMOTT, WILL & EMERY (LOS ANGELES OFFICE) 2049 CENTURY PARK EAST 34TH FLOOR LOS ANGELES, CA 90067-3208			FORD, VANESSA L	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/412,297	Applicant(s) TING, KANG	
	Examiner Vanessa L. Ford	Art Unit 1645	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see Advisory attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-2, 8-12 and 50.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on 26 March 2002 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Advisory attachment.

Advisory Action Attachment

1. Applicants amendment filed August 4, 2004 is acknowledged.
2. Applicant's amendment is not entered. The claims as amended (claims 51 and 52) will raise new issues under 35 U.S.C. 112, first paragraph and second paragraphs. For example, the newly added claims limitation "wherein the osteogenic cell is selected for a cell endogenous to a fetal calvarial cell" has not been searched or considered. Claim 51 does not further limit claim 52, in fact it broadens it and the claims would be rejected under 112 second paragraph. The newly added claims have not been searched or considered before the receipt of the after-final amendment.
3. For clarification of the record, telephone conferences were held on June 24, 2004 and July 21, 2004. The issues addressed during these telephone conferences were regarding claim 50 of the amendment filed May 10, 2004. The discussions were directed to three members of the recited Markush group of claim 50 which are stem cells, bone marrow cells and fetal embryonic cells. It is the position of the Examiner that these three members of the recited Markush group did not necessarily correlate to calvarial bone cells (see the Abstract). It should be noted that Zhang et al, 2002 teach that NELL-1 over-expression is restricted to calvarial bone. It should also be noted that Bellows et al (*Developmental Biology*, 133, 1989) (submitted by Applicant) teach that "the precursors of the osteogenic cells are believed to be derived from stem cells within the bone marrow stroma and periosteal soft connective tissue associated with bone

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surfaces (page 12). Therefore, the submitted art does not specifically teach that stem cells or bone marrow cells are definitely apart of a homogenous mixture of calvarial bone cells which are required for NELL-1 over-expression.

Applicant disagreed with this assertion and agreed to submit information disclosure statement (IDS) and references that supported their position that all recited members of the Markush group should be included.

To address Applicant's assertion that the finality of the last Office action would be withdrawn is incorrect. The Examiner stated that the IDS and submitted articles would be carefully reviewed and considered.

4. The rejection of claims 1-2, 8-12 and 50 under 35 U.S.C. 112, first paragraph is maintained for the reasons of record as set forth in pages 2-5, paragraph 6 of the Final Office Action. Applicant's arguments are directed to the newly submitted claims, which have not been entered.

Status of Claims

5. No claims allowed.

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Conclusion


6. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Vanessa L. Ford
Biotechnology Patent Examiner
September 5, 2004


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